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IPVENTURE, INC. 4010 Moorpark Avenue Suite 211 San Jose, CA 95117			GILLIGAN, CHRISTOPHER L	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* THOMAS A. HOWELL, ANGELINE HADIWIDJAJA,  
C. DOUGLASS THOMAS, and PETER P. TONG

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Appeal 2018-002961  
Application 13/358,588  
Technology Center 3600

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Before ALLEN R. MacDONALD, MICHAEL M. BARRY, and  
DAVID J. CUTITTA II, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is a decision on Appellant's Request for Rehearing.<sup>1</sup> Appellant has filed a paper under 37 C.F.R. § 41.52(a) requesting that we reconsider our Decision of July 30, 2019, wherein we affirmed the Examiner's rejections of claims 1–23. We have reconsidered our Decision in light of

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<sup>1</sup> “The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised, and Evidence not previously relied upon, pursuant to §§ 41.37, 41.41, or 41.47 are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section.” 37 C.F.R. § 41.52(a)(1).

Appellant's comments in the request, and have found no errors. We, therefore, decline to change the Decision.

Appellant's request is denied.

## DISCUSSION<sup>2</sup>

### *Section I*

In the Appeal Brief, Appellant traversed the rejection under 35 USC §103, asserting nothing in Rakowski teaches or suggests that there is any electronic evaluation. Appeal Br. 13. This Panel disagreed and pointed out that “the Marquardt analysis system is a computer based (i.e., electronic) evaluation.” Decision 19. Pursuant to 37 C.F.R. § 41.52(a)(1), Appellant contends the Board erred in its reliance on material incorporated into Rakowski. Req. Reh'g 1. In particular:

Paragraph [0059] of Rakowski *does not directly mention* anything about it being an electronic evaluation or what its beauty analysis might entail.

Req. Reh'g 1 (emphasis added).

Appellant is mistaken. Rakowski's Patent Application Publication incorporates by reference two Marquardt patents.

An example of a beauty analysis system that may be used in an embodiment of the invention is the Marquardt system, although other systems or methods may be used in place of the Marquardt system. U.S. Pat. No. 5,867,588 and U.S. Pat. No. 5,659,625 disclose and claim the Marquardt beauty analysis system, and are fully incorporated by reference herein.

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<sup>2</sup> Appellant designates the five sections of their Request for Rehearing using I–IV with IV being used twice. To avoid confusion, we refer to Appellant's second section IV as section V.

Rakowski ¶ 59. The incorporated patents are “effectively part of the host [patent] as if [they] were explicitly contained therein.” *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001) (citations omitted); *see Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1069 (Fed. Cir. 1997) (citing Manual of Patent Examining Procedure § 608.01(p) (6th ed. 1996)) (explaining that, unless indicated otherwise, incorporation by reference of a patent renders “the entire contents” of that patent’s disclosure a part of the host patent); *see also Harari v. Lee*, 656 F.3d 1331, 1335–36 (Fed. Cir. 2011). As a result, Rakowski teaches electronic evaluation via incorporation of Marquardt U.S. Pat. No. 5,659,625 (e.g., computer image analysis at columns 5–8).

### *Section II*

Pursuant to 37 C.F.R. § 41.52(a)(1), Appellant contends it was error for the Board to not [separately] review the rejection of claims 12, 13, 15 and 18 under 35 U.S.C. § 103(a). Req. Reh’g 2–3.

We disagree. At page 4 of our Decision, we treated claims 12, 13, 15, and 18 as not argued on the merits, and grouped these claims with claim 2. As to claims 12, 13, 15, and 18, Appellant merely recited claim language and provided a naked assertion that the corresponding elements were not found in the prior art Skladnev Patent Application Publication, which did not constitute a proper separate argument. App. Br. 20–23; *see* 37 C.F.R. § 41.37(c)(1)(iv); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the

claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

### *Section III*

Pursuant to 37 C.F.R. § 41.52(a)(1), Appellant contends that with respect to the rejection under 35 USC §101, “[t]he Board . . . never specified what the alleged ‘abstract idea’ is.” Req. Reh’g 3. Appellant is mistaken.

First, this Panel stated:

The Examiner correctly determines that claim 1 recites the following limitations:

[A.] receiving picture data pertaining to a photo of a region of skin,

[B.] processing the data to organize the data, storing the organized data,

[C.] evaluating the organized data to determine whether personnel should review the organized data, and

[D.] requesting the personnel to review the data.

Final Act. 3 (bracketed material added). In short, the Examiner correctly determines that claim 1 *recites* a method of “evaluating the organized data” “similar to the court-recognized abstract idea [in] *Electric Power Group*” (Final Act. 3), in which case the court held “selecting information, by content or source, for collection, analysis, and display” was not differentiated “from ordinary *mental processes*” (*Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016)). Further, evaluation is one the *mental processes* identified in the 2019 Memorandum, and thus is an abstract idea. 84 Fed. Reg. at 52.

Decision 14 (additional emphasis added).

Second, to the extent that Appellant is arguing that mere inclusion of the claim term “electronic” is sufficient to render “mental process” claims patent eligible, this is exactly the “mere recitation of a generic computer” the Court warns about in *Alice*. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208,

223 (2014). The law is clear that simply programming a computer to perform what would otherwise be an abstract idea is not sufficient to impart patent eligibility. *See Alice*, 573 U.S. at 224–25.

### DECISION

Based on the record before us now and in the original appeal, we have granted Appellant’s request to the extent that we have reconsidered our Decision, but we deny Appellant’s request to make any changes in our Decision. Appellant has not identified any points the Board has misapprehended or overlooked.

The request for rehearing is denied.

Original summary of Decision now on Rehearing:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–23	101	Eligibility	1–23	
1, 3–7, 9–11, 19–23	103	Pak, Rakowski	1, 3–7, 9–11, 19–23	
2, 8, 12–18	103	Pak, Rakowski, Landwehr, Greene, Skladnev, Yu, Altshuler	2, 8, 12–18	
12–18	112(b)	Indefiniteness		12–18
<b>Overall Outcome</b>			1–23	

Final Outcome of Appeal after Rehearing:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1-23	101	Eligibility	1-23	
1, 3-7, 9-11, 19-23	103	Pak, Rakowski	1, 3-7, 9-11, 19-23	
2, 8, 12-18	103	Pak, Rakowski, Landwehr, Greene, Skladnev, Yu, Altshuler	2, 8, 12-18	
12-18	112(b)	Indefiniteness		12-18
<b>Overall Outcome</b>			1-23	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED